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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/508,913 03/16/00 UDEM

S 33.359-01P

HM22/0605
AMERICAN HOME PRODUCTS CORPORATION
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EXAMINER

WINKLER, J

ART UNIT

PAPER NUMBER

1648

DATE MAILED:

06/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/508,913

Applicant(s)

UDEM ET AL.

Examiner

Ulrike Winkler, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-4, drawn to an attenuated respiratory syncytial virus subgroup B.

Group II, claims 5 and 6, drawn to a method of immunizing an individual to induce protection against RSV subgroup B.

Group III, claims 7 and 8 as the claims read on genome RSV, drawn to a transcription vector comprising and an isolated nucleic acid of RSV.

Group IV, claims 7 and 8 as the claims read on antigenome RSV, drawn to a transcription vector comprising and an isolated nucleic acid of RSV.

Group V, claims 9 and 10 as the claims read on genome RSV, drawn to a method of producing an infectious attenuated RSV subgroup B using a transcription vector.

Group VI, claims 9 and 10 as the claims read on antigenome RSV, drawn to a method of producing an infectious attenuated RSV using a transcription vector.

Group VII, claim 11, drawn to a nucleic acid molecule comprising an RSV subgroup B.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups I-VII appears a composition comprising an attenuated RSV subgroup B virus that contains a mutation in the polymerase L gene. Randolph et al. (EP 0 567 100 A1) discloses temperature sensitive, cold adapted RSV mutant viruses of subgroup A and B. Temperature sensitive, cold passage mutants were found to contain mutations in the polymerase gene (see Tolly et al. Vaccine 1996; Connors et al. 1995). Therefore, the technical feature linking the inventions of groups I-VII does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of group I is considered to be the attenuated RSV.

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The special technical feature of group II is considered to be a method of immunizing an individual to induce protection against RSV.

The special technical feature of group III is considered to be a genome RSV encoding transcription vector.

The special technical feature of group IV is considered to be an antigenome RSV encoding transcription vector.

The special technical feature of group V is considered to be a method of producing an infectious attenuated RSV using a genome RSV encoded transcription vector.

The special technical feature of group VI is considered to be a method of producing an infectious attenuated RSV using an antigenome RSV encoded transcription vector.

The special technical feature of group VII is considered an isolated nucleic acid comprising a RSV subgroup B in positive strand, antigenome RSV.

Accordingly, groups I-VII are not so linked by the same or corresponding technical feature as to form a single general inventive concept.

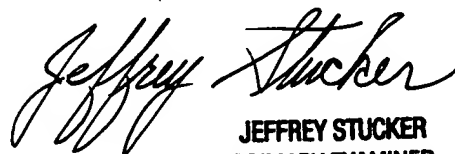
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294. The examiner can normally be reached on 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ulrike Winkler, Ph.D.


JEFFREY STUCKER
PRIMARY EXAMINER